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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,478	03/04/2002	Jin Jen	126881201800	1461
30089	7590	06/12/2006		EXAMINER
GENZYME CORPORATION C/O FOLEY & LARDNER LLP 1530 PAGE MILL ROAD PALO ALTO, CA 94304			ART UNIT	PAPER NUMBER

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT PAPER

20060608

DATE MAILED:

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Commissioner for Patents

Notice of Non-Responsive Amendment

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 14, 2006, has been entered.

Although Applicant's request for reconsideration has been entered, the amendment submitted on the same date is considered non-responsive for the following reasons:

The amendment filed April 14, 2006, would amend all claims, which were previously drawn to the elected invention, so as to present only claims drawn to non-elected inventions.

Claims 2, 4-12, and 14-30, which have been withdrawn; and claims 1 and 31-33, as would be amended, are not readable on the elected invention for the following reasons:

As originally presented, the claims, which were directed to the elected invention, were drawn to a method of aiding in the diagnosis of a neoplastic condition of a lung cell.

As claims 1 and 31-33 would be amended, the claims would be directed to a method for determining if a lung cell isolated from a patient has neoplastic potential.

The elected invention and the invention of claims 1 and 31-33, as would be amended, are patentably distinct inventions. Although the different inventions comprise the step of detecting the presence of the product of an overexpressed proto-oncogene (i.e., PGP9.5) in a biological sample comprising a lung cell, the processes are

nevertheless different because they necessarily measure different endpoints and therefore involve the establishment of different correlations. Moreover, the elected invention measures the onset or presence of a neoplastic condition of the lung (e.g., lung carcinoma), and involved establishing a correlation between the presence of PGP9.5 in a sample comprising a lung cell and the presence in the sample of a neoplastic lung cell. In contrast, the invention of claims 1 and 31-33, as would be amended, measures the potential of a lung cell to become neoplastic (e.g., the potential of lung cell to undergo transformation to a cancerous state), and thus necessarily involves establishing a correlation between the presence of PGP9.5 in a sample comprising a lung cell and the relative likelihood that the sample comprises cells that will become neoplastic. Because these different processes comprise the measurement of different endpoints and involve the establishment of different correlations, they are expected to have different criteria for success. As an additional difference, though the different processes comprise detecting the presence of PGP9.5 in a biological sample comprising a lung cell, the elected invention might be ordinarily practiced with a sample acquired from a subject (e.g., a patient) suspected of having a neoplastic condition of the lung. In contrast, the process of claims 1 and 31-33, as would be amended, would necessarily be practiced using a sample acquired from a subject before the onset of manifestations of a neoplastic condition of the lung, since its aim would be understood to screen patients to identify those at increased risk of developing such a condition or disease. As such, the inventions are materially different processes, as they would be practiced using samples acquired from different populations of patients.

Because the subject matter of the originally present claims, which were already examined on the merits as encompassing the elected invention, and the subject matter of claims 1 and 31-33, as would be amended, differ so substantially, examination of the amended claims would require new and different considerations and searches, which were not before necessary. As such, examination of the claims, as would be amended, would be unduly burdensome.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, after entry of the amendment, all remaining claims would be withdrawn from consideration as being directed to non-elected inventions, and therefore the amendment, which presents only claims drawn to such non-elected inventions, is non-responsive. See 37 CFR 1.142(b) and MPEP § 821.03.

Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

1 *✓*
Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1643

slr
June 9, 2006